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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,419	08/01/2001	Michael Dutka	M-101	6385

7590 08/28/2002  
Joseph P. Errico  
150 Douglas Road  
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EXAMINER

PAYNE, SHARON E

ART UNIT PAPER NUMBER

2875

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,419

Applicant(s)

DUTKA ET AL.

Examiner

Sharon E. Payne

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the outer translucent screening member (claim 20) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "108" has been used to designate both a light source and an inner cylinder (page 12, line 1). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "340a" and "304a" have both been used to designate the mounting arm (page 12, line 25). A proposed drawing correction or corrected drawings are required in reply to

the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murch (U.S. Patent 147,960) in view of Barnes (U.S. Patent 40,898).

Regarding claim 16, Murch discloses a first support element (reference character G), a light source supported on the first support element (reference character F), a second support element (reference character A) dimensioned to fully encompass the first support element without touching the first support element (Fig. 1), the second element further supporting an outer opaque screening member (reference numbers 1, 2, 3, 4 and character A) adapted for use is selectively covering at least a portion of the inner translucent screening member (Fig. 1).

Murch does not disclose the second element supporting an inner translucent screening member.

Barnes discloses the second element supporting an inner translucent screening member (reference character J) dimensioned to encompass the light source without touching the light source (Fig. 3).

It would have been obvious to one of ordinary skill in the art to use the inner translucent screening member of Barnes in place of the chimney of Murch for diffusing or tinting the light.

Concerning claim 17, Murch discloses the outer opaque screening member comprising a solid member (frame, A) that is dimensioned to encompass the inner translucent screening member (Fig. 1).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murch and Barnes as applied to claim 16 above, and further in view of Webber (U.S. Patent 56,647).

Regarding claim 19, Murch does not disclose an opaque folding door. Webber discloses an opaque folding door (shade, reference character g) that can be closed about the inner translucent screening member and alternatively opened to reveal at least a portion of the inner translucent screening member (Fig. 3).

It would have been obvious to use the opaque folding door of Webber in the apparatus of Murch for concealing the light source.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murch and Barnes as applied to claim 16 above, and further in view of Simpson (U.S. Patent 5,513,084).

Regarding claim 20, Murch does not disclose the outer translucent screening member. Simpson discloses an outer translucent screening member (reference number 24, column 2 in lines 62-64) covering at least a portion of the outer opaque screening member to enclose that portion of the outer opaque screening member (reference character B) between the inner

translucent screening member (reference number 23) and the outer translucent screening member (reference number 24, Fig. 1).

It would have been obvious to one of ordinary skill in the art to use the outer translucent screening member of Simpson in the apparatus to enclose the outer opaque screening member of Murch between the two translucent screening members.

***Allowable Subject Matter***

10. Claims 1-15 are allowed.

11. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter. The prior art fails to disclose an illumination device having the following features:

1) two cylindrical housing members disposed around a light source, each with portions of the sidewalls that are translucent and portions that are opaque with at least one of the cylindrical housing members being rotatable as recited in claim 1;

2) first and second screening members each having translucent and opaque portions with at least one being translatable relative to the other such that light may pass in one configuration and be blocked in another as recited in claim 9; and

3) an opaque screening member comprising at least two opaque panels, at least one of which is movable relative to the other as recited in claim 18.

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**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon E. Payne whose telephone number is (703) 308-2125. The examiner can normally be reached on regular business hours.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

sep  
August 15, 2002

  
**ALAN CARIASO**  
**PRIMARY EXAMINER**